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REMARKS

The present amendment is prepared in accordance with the requirements of 37 CFR 1.121.

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the personal interview between U.S. Patent Examiner Dang D. Le and the undersigned Counsel Steven J. Miller, Esq., conducted on September 15, 2006, clarifying what the Applicant considers its invention, the amendments above and the remarks below.

Claims 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 13, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26 and 28 were previously canceled by the Applicant, claims 14 and 29 were canceled, pursuant to an Examiner's Amendment (see Final Office Action mailed August 31, 2006) made after a telephone communication with the undersigned counsel. Independent claims 1 and 16, have been presently amended, to place them in a better form, and new dependent claims 31 and 32 have been added, pursuant to Examiner's comments from said Interview between the Examiner and the undersigned counsel. No new matter has been added.

CLAIM REJECTIONS – 35 USC 103

1. In the Final Office Action mailed on August 31, 2006, the Examiner has rejected Claims 1, and 16 as being unpatentable over MASAKI (JP 02-074146) in view of LEHDE (US 2,807,734), because the subject invention would have been obvious, when taking

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MASAKI and LEHDE in combination, to one skilled in the art. The applicant respectfully traverses the Examiner's position on this issue. As discussed with the Examiner in the Interview between the Examiner and the undersigned counsel on September 15, 2006, a careful review of the entire English translation of MASAKI, clearly indicates that MASAKI claims a "magnetic" body, which may be made of "iron" [part # 3] (see Applicant's certified English translation of MASAKI previously filed last June 2006, page 4 line 10), notwithstanding any other suggested magnetic characteristics and definitions for 'iron' contained in other patents cited by the Examiner, and which are taken in a different context (i.e., each patentee/applicant is his own lexicographer for the potential variant magnetic characteristics that he is claiming) [see Examiner's comments in Final Office Action mailed on August 31, 2006, paragraph # 2, referencing certain definitions or characteristics for 'iron' in HUANG (6,906,517) and VAN BIJSTERVELD (6,824,329) patents, and conversely, see and compare to Applicant's generally accepted definitions in Exhibits B, C and D attached hereto with the undersigned counsel's document authenticity 37 CFR 1.132 Declaration. 'Iron' has many isotopes and allotropes. Certain allotropes of common iron isotopes are "magnetic" (i.e. have appreciable residual magnetism) (see the aforementioned Exhibit C, for alpha, beta, gamma and delta allotropic forms of iron and their "magnetic" characteristics; the alpha allotope is "magnetic" but the beta, gamma and delta allotropes are not, so a comment in prior patents that iron is "non-magnetic" is necessarily overly broad, and must be taken in the specific context of that particular patent and its specific art area)], on MASAKI's

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rotor that does not have permanent magnets. The undersigned counsel clarified with the Examiner in the September 15, 2006 Interview, that the subject invention specifically has not, and does not, claim anywhere in the subject application disclosure, any reliance on the residual magnetism or "magnetic" properties on materials on the rotor that does not have permanent magnets; but, as stated above, MASAKI does, in fact, claim a "magnetic" body (see references to part # 3 in MASAKI) on its rotor that does not have permanent magnets. The present invention specifically requires, through specific negative limitations, that permanent magnetic elements exist on only one of the two rotors, and that no ferromagnetic materials exist on the rotor without the permanent magnets, but that said non-permanent magnet rotor does have magnetically permeable materials (which may be "ferrous" material which is not ferromagnetic; see aforementioned Exhibits B, C and D attached) and electro-conductive elements. Therefore, since MASAKI does not have each and every limitation or element to the subject claimed invention, MASAKI does not anticipate the subject invention, and therefore the subject invention is novel over MASAKI. "Anticipation requires that each and every element of the claimed invention be disclosed in a *single* prior art reference" In re Spada, 911 F.2d 705 (Fed. Cir. 1990). Further, given this clarification of the subject invention, MASAKI, in view of LEHDE (2,807,734) cannot, and does not, suggest, or teach towards, the Applicant's subject invention [see paragraph # 5 of Final Office Action mailed on August 31, 2006]; in fact, MASAKI specifically teaches away from the applicant's invention, by suggesting the use of a "magnetic" (residual magnetism) body on the rotor that does not have permanent

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magnets. The Applicant's invention, to the contrary and by negative limitation, specifically claims that there are no ferromagnetic materials used on the rotor without the permanent magnets. Addressing LEHDE, although it provides a means for varying one rotors position relative to the other rotor, LEHDE does not disclose one rotor with permanent magnets and the other rotor with electro-conductive elements and magnetically permeable material that is not ferromagnetic which is claimed by the subject invention; to the contrary, LEHDE specifically suggests the opposite, by disclosing and claiming, that LEHDE's rotor that does not have permanent magnets, **does have**, in fact, "...magnet material...for present purposes may be understood [LEHDE's lexicography here] to mean any magnetic material having a relatively high hysteresis coefficient" [see LEHDE, Col. 1, lines 35-40; also compare with "ferromagnetic" definition in the subject Applicant's Exhibit B of undersigned counsel's 37 CFR 1.132 Declaration attached hereto...Ferromagnetic = "...relating to substances with... "...appreciable residual magnetism and hysteresis"]. Therefore, LEHDE **does** require "magnetic" elements on the rotor that does not have permanent magnets. Consequently, LEHDE not only does not suggest, but specifically teaches away, both individually, and in combination with MASAKI, from the subject invention; said subject applicant's invention specifically not requiring, by specific negative limitation, any ferromagnetic materials, and permanent magnets, on the rotor that does not have permanent magnets. Therefore, considering the current application as a whole when compared to MASAKI and LEHDE, the subject invention would not have been obvious to one skilled in the art at the time of the filing of

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the subject application.

2. In paragraph # 6 of the Final Office Action mailed on August 31, 2006, the Examiner has rejected Claim 1 as being unpatentable over DENK (5,292,284) in view of LEHDE (2,807,734), because the subject invention would have been obvious, when taking DENK and LEHDE in combination, to one skilled in the art. The applicant respectfully traverses the Examiner's position on this issue. DENK (5,292,284) discloses permanent magnets on both of its rotors [see DENK, see col. 1, lines 21-22..."...permanent magnets on the two rotors..."]. DENK also discloses that its magnetically permeable materials cited by the Examiner (DENK part # 14) [see paragraph #6 in Final Office Action] mailed August 31, 2006], are, in fact, "ferromagnetic" [see DENK Col. 2, line 64]; the Applicant has in its instant invention, specifically claimed, by negative limitation, that its magnetically permeable materials, as well as its electro-conductive materials, are not ferromagnetic. In addition, the present invention specifically requires, through specific negative limitations, that permanent magnetic elements exist on only one of the two rotors, and that no ferromagnetic materials exist on the rotor without the permanent magnets, but that said rotor does have magnetically permeable materials (which may be made of a non-ferromagnetic "ferrous" material; see aforementioned Exhibits B, C and D attached hereto) and electro-conductive elements. Therefore, given the aforementioned clarification of the subject invention, DENK in view of LEHDE, cannot, and does not, suggest or teach towards the Applicant's subject invention. Therefore, considering the

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current application as a whole when compared to DENK and LEHDE, the subject invention would not have been obvious to one skilled in the art at the time of the filing of the subject application.

3. In paragraph # 7 of the Final Office Action mailed on August 31, 2006, the Examiner has rejected Claim 16 as being unpatentable over LEHDE (2,807,734) in view of MURPHY (3,860,064), because the subject invention would have been obvious, when taking LEHDE and MURPHY in combination, to one skilled in the art. The applicant respectfully traverses the Examiner's position on this issue. MURPHY (3,860,064) discloses permanent magnets on both of its rotary members [see MURPHY, see Fig. 1 parts 18, 19 and see col. 2, lines 32-35 "...carries a magnet in the form of a ring 18. A second magnet 19, ... "the magnets 18 and 19..."; also see Col. 1 lines 32-34, "Preferably the said coupling comprises a first magnet attached to the drive and a second magnet attached to the fan,..."]. In addition, MURPHY discloses that one of the members may be made of "ferromagnetic" material [see MURPHY, col. 1, lines 37-39]. The present invention specifically requires, through specific negative limitations, that permanent magnetic elements exist on only one of the two rotors, and that no ferromagnetic materials exist on the rotor without the permanent magnets, but that said rotor does have magnetically permeable materials (which may be made of a non-ferromagnetic "ferrous" material; see the aforementioned Exhibits B, C and D attached hereto) and electro-conductive elements. Therefore, given the aforementioned

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clarification of the subject invention, LEHDE in view of MURPHY, cannot, and does not, suggest or teach towards the Applicant's subject invention. Therefore, considering the current application as a whole when compared to MURPHY and LEHDE, the subject invention would not have been obvious to one skilled in the art at the time of the filing of the subject application.

4. Like MASAKI, LEHDE, DENK and MURPHY, none of the other previously cited prior art suggests or teaches to the use of permanent magnets on only one of two rotors, and the non-permanent magnet rotor having electro-conductive elements and magnetically permeable elements that are not ferromagnetic. In fact, said cited prior art, whether alone or in combination, when compared to the Applicant's invention, specifically does not suggest, and specifically does teach away from, the Applicant's invention. As stated by the Court of Appeals for the Federal Circuit: "Further, in combining the elements selected from different references, the references must be considered as a whole, including any disclosures in them that teach away from the combination claimed by the inventor in his patent", W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1989).

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CONCLUSION

Attached hereto is a marked-up version of the changes made to the specification, currently amended claims and new claims.

It is noted that the amendments are made only to more completely define the invention and place them in a better form based on Examiner's comments. No new matter has been added.

In view of the foregoing, it is respectfully submitted that the application has now been brought into a condition where allowance of the case is proper, and issuance of a Notice of Allowance is requested. Consideration of the amendments herein is hereby respectfully requested, as well as consideration of new claim numbers 31 and 32, based on the clarification of what the Applicant considers its invention discussed above and in the Interview with the Examiner on September 15, 2006, and the related arguments herein.

Should the Examiner find the application to be other than in condition for allowance, Applicant's Attorney respectfully requests that the Examiner call the undersigned to clarify any issue and/or the amendment.

Originally Submitted: October 5, 2006

Resubmitted November 22, 2006, to comply with Legal Instruments Examiner Linda Spruell's comments, mailed October 23, 2006.

Respectfully Submitted,



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Transmitted via Fax to the USPTO at 571-273-8300

Resubmission Date of Transmission: November 22, 2006

I hereby certify that this correspondence, including the attachments listed on the accompanying Transmittal, is being transmitted via facsimile machine on the date indicated above and is addressed to Commissioner of Patents, PO Box 1450, Arlington, VA 22313-1450.



Steven J. Miller, Esq.